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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,252	09/05/2000	Lee Cannon	100-114P2	7732

7590 05/20/2002

Daniel P Esq
Galgano & Burke
U S Federal Courthouse Building
300 Rabro Drive Suite 135
Hauppauge, NY 11788

EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 05/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/655,252

Applicant(s)

CANNON ET AL.

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 15 January 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a continuation-in-part of Application No. 09/157,993, filed September 22, 1998." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included. While such a statement appears in the specification, it is not the first sentence. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 18 & 19 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the function of the secondary gaming unit and the randomly generated indicia displayed thereon. The secondary gaming unit evidently generates and displays a random indicia, but what does it do with it afterwards? Does this indicia have any effect on the game? Or is it merely a decorative device intended to add visual interest?

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-11, & 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Clapper, Jr. (US Patent Number 5,609,337) (henceforth, Clapper '337).

Claim 1: Clapper '337 describes a gaming device with means for receiving a wager (18). There is a means for playing a wagering game in which the player's success is randomly determined. (Abstract) There is a means for providing a gaming award when the player is successful in the wagering game. (Abstract) There is a means for dispensing a ticket (20) that are not dependent on the occurrence of a winning outcome.

Claim 2: The playing means is a reel display (Fig 10).

Claim 3: The playing means has a video display (14).

Claim 4: The means for dispensing at ticket (20) is operable independent of the means for providing a reward.

Claim 5: The providing means and the dispensing means are a ticket dispenser (20).

Claims 6, 7, 8, 9: The dispensing means (20) dispenses a ticket every time the game is played. This includes those times in which a player does not receive an award.

(Abstract)

Claim 10: The dispensing means dispenses a ticket randomly (i.e., in a random order).

Claim 11: Clapper '337 teaches randomly dispensing the tickets. Furthermore, Clapper '337 says, "the player is *usually* required to deposit the necessary amount of money in order to actuate the apparatus and thereby play the game." (Col 4, 10-12) This inherently means that the device may dispense a ticket when the player has not deposited money in the machine – i.e., is not playing.

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Claim 31: The ticket is in different form from the gaming award. The gaming award may be cash. (Abstract) This is a different form than the ticket.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapper '337 as applied to claim 1 above, and further in view of Boushy (US Patent Number 5,761,647).

Claim 12: Clapper '337 teaches the invention substantially as claimed. Clapper '337 does not, however, teach use of a player tracking card. Player tracking cards are extremely well known in the art and allow the casino to track the habits of the players so that the casino may design a personalized marketing plan. Boushy teaches the use of such a card. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have required the use of a player tracking card in order to receive a ticket so that the casino can gather information about the player in order to create a personalized marketing plan.

Claim 16: Clapper '337 teaches the invention substantially as claimed. Clapper '337 does not, however, teach the award of tickets redeemable for services supplied by the gaming establishment (comps). Boushy teaches that casinos often award comps to players in order to reward frequent play. (Abstract) Frequent play increases the casino's

profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have awarded tickets redeemable for services supplied by the gaming establishment in order to reward and encourage frequent play, thus increasing casino profits.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clapper '337 as applied to claim 1 in view of Clapper, Jr. et al. (US Patent Number 5,928,082). (Henceforth, Clapper '082)

Claim 13: Clapper '337 teaches the invention substantially as claimed. Clapper '337 does not, however, teach dispensing promotional tickets. Clapper '082, which is the same device, teaches the use of promotional tickets. Clapper '082 teaches that the use of promotional tickets increases the sales of items such as pre-paid phone cards. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have issued promotional tickets in order to increase the sales of such items as pre-paid phone cards.

9. Claims 14 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapper '337 as applied to claim 1 in view of Burns et al. (US Patent Number 6,048,269)

Claims 14 & 15: Clapper '337 teaches the invention substantially as claimed. Clapper '337 teaches dispensing tickets that may have different values. (Col 4, 2-9) Clapper '337 does not, however, specifically teach dispensing "free game" tickets. Burns teaches a slot machine that dispenses tickets, including tickets redeemable for "free play" credits. (Fig 3) These credits could be used on any gaming device. Issuing "free play" tickets is a way of rewarding players without actually having to pay out cash. This increases the

profits for the casino. It would have been obvious to one of ordinary skill in the art at the time of the invention to have dispensed "free play" tickets that could be redeemed on any game machine in order to reward the player without actually having to pay out cash, thus increasing the profits of the casino.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clapper '337 as applied to claim 1 above, and further in view of Harrison (US Patent Number 5,934,671).

Claim 17: Clapper '337 teaches the invention substantially as claimed. Clapper '337 teaches a ticket in which the indicia are covered. While Clapper '337 teaches a ticket with a pull-tab cover for the indicia, it does not specifically teach a scratch-off cover for the indicia. Pull-tab covers and scratch-off covers are functionally equivalent and well known to the art. Harrison teaches this equivalence. (Col 6, 7-13) Scratch-off covers are cheaper to make than pull-tab covers since the latex used to make the cover can be applied as part of the printing operation. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used a scratch-off ticket in order to cut costs.

11. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapper '337 as applied to claim 1 above, and further in view of Baerlocher et al. (US Patent number 5,788,573).

Claims 18-19: Clapper '337 teaches the invention substantially as claimed. Clapper '337 does not, however, teach a secondary gaming unit with a wheel to display a randomly generated indicia. Baerlocher teaches use of a secondary gaming unit in the form of a wheel to display randomly generated indicia. (Fig 4) Such "wheels of

fortune” are common to the art and are often used to display randomly generated indicia. These displays add visual interest to the gaming device. It would have been obvious to one of ordinary skill in the art to have a secondary display in the form of a wheel to display a randomly generated indicia in order to add visual interest to the gaming device.

12. Claims 20-27, 30, & 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapper ‘337 as applied to claim 1 above, and further in view of Mullins (US Patent Number 5,158,293) and Burns.

Claims 20 & 23: Clapper ‘337 teaches the invention substantially as claimed. It teaches the dispensing of lottery tickets worth various amounts. (Col 4, 2-9) Clapper ‘337 does not, however, specifically teach that the tickets may be for both an instant win game and a drawing, nor does it teach a “free game” prize. Mullins teaches a ticket in two parts – an instant win part and a part for use in a drawing. (Fig 1) Mullins teaches that this configuration allows players to participate in two type of lottery game at once. (Col 1, 66-68) This increases the popularity of the lottery game – thus leading to more ticket sales. It would have been obvious to one of ordinary skill in the art at the time of the invention to have adopted a two-part ticket that allowed participation in both an instant win game and a drawing lottery in order to allow players to participate in both types of game at once, thus increasing the popularity of the game and leading to more ticket sales.

As noted above, Clapper ‘337 teaches dispensing tickets with various values. (Col 4, 2-9) Clapper ‘337 does not, however, specifically teach dispensing “free game” tickets. Burns teaches a slot machine that dispenses tickets, including tickets redeemable for “free play” credits. (Fig 3) These credits could be used on any gaming device.

Issuing “free play” tickets is a way of rewarding players without actually having to pay out cash. This increases the profits for the casino. It would have been obvious to one of ordinary skill in the art at the time of the invention to have dispensed instant game tickets that included “free play” tickets that could be redeemed on any game machine in order to reward the player without actually having to pay out cash, thus increasing the profits of the casino.

Claim 21: Mullins shows a single, two-part ticket. (Fig 1)

Claim 22: Mullins, figures 4 & 5 disclose use of separate instant game and drawing tickets. Clapper ‘337, Figure 2 shows two side-by-side ticket dispensers. (Col 7, 54-67)

Claim 24: Mullins teaches automatically selecting at least one indicia from a predetermined set of indicia for the drawing. (Col 3, 59-61)

Claim 25: Mullins teaches randomly selecting the indicia. (Col 3, 59-61)

Claim 26: Mullins teaches that the indicia are numbers. (Col 3, 59-61)

Claim 27: Mullins teaches an embodiment with means for receiving a player’s selection of at least one indicia from a predetermined set of indicia for the drawing. (Col 5, 12-15)

Claim 30: Mullins teaches that the indicia are numbers. (Fig 5)

Claim 32: Mullins teaches that the dispensing means may print the tickets. (Col 4, 66 – Col 5, 1) This allows the player to choose indicia for a drawing-type lottery. (Col 5, 12-15) It would have been obvious to one of ordinary skill in the art at the time of the invention to have the dispensing means may print the tickets so that the player may choose the indicia for a drawing-type lottery.

13. Claims 28 & 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapper '337, Mullins, & Burns as applied to claim 27 above, and further in view of Libby et al. (US Patent Number 4,982,337)

Claim 28: Clapper, Mullins and Burns teach the invention substantially as claimed.

Mullins teaches allowing the player to choose indicia for a drawing-type lottery. (Col 5, 12-15) Mullins is silent concerning how these indicia are entered into the device.

Keypads are well-known devices for data entry. Libby teaches a device for vending lottery tickets that includes a keypad (68). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included a keypad for data entry in order to implement the disclosure of Mullins.

Claim 33: Clapper, Mullins and Burns teach the invention substantially as claimed.

Mullins teaches that the indicia may be generated by a computer (Col 5, 12-15), but is silent about the location of this computer. Libby, another system for dispensing lottery tickets, teaches a central station (16) connected to a plurality of online vendor stations (12). This central station has a random number generator (38). Generating the indicia at a central computer allows the lottery ticket terminals to be less expensive since they do not require as much computer hardware. It would have been obvious to one of ordinary skill in the art at the time of the invention to print the indicia corresponding to at least one of a plurality of signals generated at a location remote from the gaming device so that the gaming device would be less expensive.

Claim 34: Libby teaches a central station (16). This central station corresponds to the gaming establishment.

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Claims 35 & 36: The signals to generate a lottery ticket would obviously be sent in direct response to operator input. In other words, when the player pays for a ticket, there is operator input. This triggers the central station to generate a signal corresponding to the indicia.

14. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clapper '337, Mullins & Burns as applied to claim 27 above, and further in view of Wilder (US Patent Number 5,408,417).

Claim 29: Clapper, Mullins and Burns teach the invention substantially as claimed. Mullins teaches allowing the player to choose indicia for a drawing-type lottery. (Col 5, 12-15) Mullins is silent concerning how these indicia are entered into the device. Touch screens are well-known devices for data entry. Wilder teaches a device for vending lottery tickets that includes a touch screen (11). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included a touch screen for data entry in order to implement the disclosure of Mullins.

15. Claims 37-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boushy.

Claim 37: Boushy discloses a method for conducting a wagering game. (Abstract) There is a gaming device (130) with means for playing a wagering game that provided a player with the opportunity to make a wager. As with all slot machines, the outcome is randomly determined. Boushy provides a method for accumulating comps points (Abstract). Boushy teaches that the comp points have a monetary value and may be used in the place of cash. (Col 3, 13-16) This would obviously include being used to activate the gaming machine. Boushy does not, however, explicitly teach displaying a visible

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indication of the player's accumulated comp points. However, in order to allow the player to redeem the comp points, the player would have to know how many comp points had been accumulated. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a visible display of the accumulated comp points in order to allow the player to know how many comp points had been accumulated, thus aiding in the redemption of these points.

Claim 38 & 39: Boushy teaches that the comp points may be used in the place of money in the casino. (Col 3, 13-16) This would naturally include at the gaming devices.

Boushy, does not, however, explicitly teach the details of the gaming devices. In order to use the comps points in the place of cash, the player would have to be presented the option of redeeming the comp points. Furthermore, the player would have to know the value of the comp points at any given time. It would have been obvious to one of ordinary skill in the art at the time of the invention to have displayed at least one redemption option (which would change to reflect the monetary value of the accumulated comps points) to a player at the gaming device in order to facilitate the player's use of comp points in the place of cash.

Claims 40 & 41: Boushy teaches the requirement that the player input player identification prior to a transaction involving comps. (Col 5, 58-60) This would naturally include prior to displaying the player's accumulated comps points and prior to allowing the comps points to be redeemed. If no such input were required, the system could not function – how would it know which player's account to display or redeem?

Claims 44-47: Boushy teaches accumulating a plurality of comp values according to different comp criteria. (Col 5, 16-19) The comp values have corresponding comp awards. (I.e., The player gets more points for certain activities.) The player may continue to accumulate points even after the player has reached a comp value level that qualifies for an award.

All activities that are eligible for “comping” get an award of comp points for the player. As pointed out at Col 5, 16-19, some activities earn a larger award than others. Whenever a player participates in any of these activities, the player receives comp points – even if the player has already had an award of comp points.

16. Claims 42 & 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boushy as applied to claim 37 above, and further in view of Burns et al.

Claim 42: Boushy teaches award of comps that may be redeemed by a player for casino goods and services. Boushy does not, however, teach printing out a ticket showing the value of the comps points so they may be redeemed. Burns teaches printing such tickets. This allows the cashless operation of gaming machines. (Abstract) Cashless operation of gaming machines reduces the requirement to hire security guards, thus decreasing costs of operating a casino. It would have been obvious to one of ordinary skill in the art at the time of the invention to have dispensed a ticket which is redeemable for goods and services from the gaming device in order to provide for cashless operation of the gaming machines reducing the requirement to hire security guards, thus decreasing costs of operating a casino.

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Claim 43: Boushy teaches playing a wagering game on a gaming machine. Boushy does not, however, teach the details of the gaming machine operation. Nor does Boushy specifically teach printing out a redeemable ticket from the gaming machine. Burns teaches printing such tickets. This allows the cashless operation of gaming machines.

(Abstract) Cashless operation of gaming machines reduces the requirement to hire security guards, thus decreasing costs of operating a casino. It would have been obvious to one of ordinary skill in the art at the time of the invention to have dispensed a redeemable ticket from the gaming device in order to provide for cashless operation of the gaming machines reducing the requirement to hire security guards, thus decreasing costs of operating a casino.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These are other gaming systems.

Reference Name	US Patent Number
Hogan	6,267,671
Walker et al.	6,193,608
Dickinson et al.	5,265,874
Bouedec	5,628,684
Kelley et al.	5,816,918

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319.

The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's Primary Examiner, Jessica Harrison can be reached on (703) 308-2217. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



cbc
May 9, 2002



JESSICA HARRISON
PRIMARY EXAMINER